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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,798	09/19/2000	Naoki Kato	2257-162P	1865

2292 7590 01/07/2005

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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/664,798	KATO, NAOKI	
	Examiner	Art Unit	
	Vincent F. Boccio	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/985,779.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/19/00</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7, {which is a combination of claims 1, 3 & 7} of U.S. Patent No. 6,243,530. Although the conflicting claims are not identical, they are not patentably distinct from each other because see below.

Application claim 14, being a method claim as recited corresponds to patented apparatus claim 7, is deemed not considered to be patentable distinct from the application claim, and considered to be obvious in view of the apparatus which performs the method.

Claim 14 a recording device recites,

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- a record standby signal generating portion, recited in claim 3;
- step A, detecting the signal the generated signal, met by, "the ID distinguishing portion", recited in claim 7;
- steps B & C, are also recited, in view of both first and second signals indicate performance (claim 1), wherein in accord to claim 3, based on the standby signal generating portion, either the first or second ID signals are output, claim 3, and detected by the distinguishing portion, claim 7;
- step D, "detecting the second ID", "distinguishing portion", as recited in claim 7;
- steps E & F, when the second or first is detected, based on the switching portion, which outputs either the first or the second, detected by distinguishing portion, the system outputs one of the two signals, as recited in claims 3 & 7, outputting one of based on the standby signal, as recited in claim 3.

Allowance of claim 14 of the instant application would result in a time-wise extension of the monopoly previously granted for the invention defined by patent claim 7, therefore, obviousness type double patenting is deemed proper.

Allowable Subject Matter

3. Claim 13 is allowed.

4. The following is an examiner's statement of reasons for allowance:

Regarding claim 13, the prior art of record fails to teach disclose or fairly suggest the combination associated with a video display/record system comprising a video signal recording device, a video signal output device and an external device externally connected to the recording device, wherein the recoding device comprises:

- an identification signal generation portion for generating a first identification signal indicating performance of the recording device,
- an identification signal switching portion receiving at least one second identification signal from said

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external device, indicating performance of said external device, and said first identification signal, outputting one of said first or second identification signals, to said video signal output device depending on whether recording operation is performed or not, and

- a recording standby signal generating portion for outputting a recording standby signal directing to enter recording operation,
- said identification signal switching portion switching whether to output said first identification signal or said second identification signal from said identification signal switching portion on the basis of said recording standby signal, and

said video signal output device comprises:

- an identification signal distinguishing portion for distinguishing which of said first and second identification signals from said identification signal switching portion is inputted, and a screen display resolution setting portion for setting a displayable range of said video signal in accordance with each of said external device and said recording device on the basis of a result of distinction in said identification signal distinguishing portion.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Contact Fax Information

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication
intended for entry)

or:

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(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent
12/8/04


VINCENT BOCCIO
PRIMARY EXAMINER